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| EXAMINER |
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CROW, ROBERT THOMAS

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1634

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment

1. For the purpose of appeal, the proposed amendment(s) will be entered and the proposed rejection(s) detailed below will be included in the Examiner's Answer. To be complete, such rejections must be addressed in any brief on appeal.

2. No claims are cancelled. Claims 16-17 are withdrawn. Claims 1-15 and 18-25 are under prosecution.

3. Upon entry of the amendment(s) for purposes of appeal:

A. Claims 1-15 and 18-25 would be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the reasons detailed in the Final Office Action mailed 6 June 2008.

I. Applicant argues on pages 7-8 of the Remarks filed 6 August 2008 (i.e., the "Remarks") that the recitations of "at least one spacer" and "at least one gasket" has implicit support in the specification because page 11, lines 16-30 of the instant specification implicitly supports "any number of spacers on the support," and because it is implicit in the drawings that any number of spacers will fit on a substrate. Applicant also argues on page 8 of the Remarks that page 11, lines 4-6 of the specification implicitly support at least one gasket, and that it is implicit that "at least one gasket" covers as many gaskets that will fit on the substrate.

However, all of the recitations of a spacer on page 11 of the specification specifically refer to "the spacer 129," which is clearly a singular recitation of a spacer. In addition, all of the references to a gasket on page 11 specifically refer to "the gasket

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127," which is clearly a singular recitation of a gasket. Page 11 does refer to Figure 4a, which shows two structures labeled 129 and two structures labeled 127.

However, the phrase "at least one" is indicative of a range of numbers of gaskets or spacers, wherein the range as claimed has no upper limit. As noted in Section 5 of the Final Office Action mailed 6 June 2008, while Figure 4A shows two gaskets (labeled 127) and two spacers (labeled 129), and Figure 5B shows two gaskets 127 and four spacers 129, the specification does not show more than two gaskets or four spacers. Furthermore, a review of the specification yields no recitation of either "at least one spacer" or "at least one gasket." Thus, the claimed range of "at least one spacer" and the claimed range of "at least one gasket" encompasses a plurality of gaskets and spacers that exceeds the range actually taught by the instant specification. Therefore, the instantly claimed "at least one spacer" and "at least one gasket" constitute new matter and the rejection would be maintained.

II. In response to Applicant's argument that it is implicit from the drawings that the substrate can accommodate any number of spacers or gaskets, it is noted that the courts have held that "[w]hen the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value" (*Hockerson-Halberstadt, Inc. v. Avia Group Int 'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000)). A review of the specification yields no teaching of the scale of the drawings. Thus, Applicant's assertion that the drawings implicitly support more than the specifically illustrated number of gaskets and spacers is not convincing and the rejections would be maintained. See MPEP 2125.

III. Applicant also argues that because there is no limitation on the size of the substrate, there is accordingly no limit to the number of gaskets or seals.

However, as noted above, the specification contains no recitation of any substrate having more than two gaskets or four spacers. Thus, as noted above, the claimed range of “at least one spacer” and the claimed range of “at least one gasket” encompasses a plurality of gaskets and spacers that exceeds the range actually taught by the instant specification. Therefore, the instantly claimed “at least one spacer” and “at least one gasket” constitute new matter and the rejection would be maintained.

B. Claims 1-3, 5-6, 9, 13, and 18-23 would be rejected under 35 U.S.C. 103(a) as being unpatentable over Dahm et al (U.S. Patent No. 6,399,394, issued 4 June 2002) in view of Lyman et al (U.S. Patent No. 6,555,361 B1, issued 29 April 2003) for the reasons detailed in the Final Office Action mailed 6 June 2008.

I. Applicant argues on page 9 of the Remarks that in column 9, lines 34-39, Dahm et al teaches away from a spacer having a height less than the gasket.

However, a review of column 9 of Dahm et al yields no statement that the height of the spacer is required to be higher than the height of the gasket; rather, column 9 merely states that the studs 50 (i.e., the spacers of the instant claims) “help in guiding substrate 10 into correct registration with gasket 60” and thus makes no mention of the requirement of any height whatsoever with respect to the guiding into correct registration. In addition, nowhere in column 9 does Dahm et al explicitly state that the device is inoperable or otherwise compromised if the height of the spacer is less than

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the height of the gasket, nor does a review of Dahm et al yields any recitation concerning the relative height of the stud (i.e., spacer) relative to the gasket.

Furthermore, column 9 of Dahm et al specifically states that the apparatus of claims 4 through 6 “can be” used by aligning the components and assembling them together as “best illustrated” in Figure 5 (lines 22-25). The phrases “can be” and “best illustrated” clearly indicated that the examples and Figures presented are non-limiting embodiments, and thus do not limit the relationship of the spacer and gasket dimensions. Applicant’s arguments regarding the alleged teaching away from a spacer having a height less than the gasket are not persuasive.

II. Applicant further argues on page 10 of the Remarks that the Office Action does not argue that Lyman teaches a spacer having a height less than a gasket, and that Lyman et al does not even teach a spacer.

However, as explicitly stated in Section 8 of the Final Office Action mailed 6 June 2008, Lyman et al teach an array hybridization apparatus (Title) comprising a thermoplastic substrate, wherein thermoplastics have the added advantage of providing resistance to the full range of conditions to which the apparatus is exposed (i.e., during hybridization procedures; column 4, lines 1-10). **The apparatus further comprises a spacer in the form of raised ring 26, which is slightly shorter than the thickness of the o-ring gasket (Figure 3 and column 3, lines 10-60).**

Further, as explicitly stated in lines 1—15 of column 3 of Lyman et al, “groove 30 is sized to receive **a rubber o-ring whose thickness will preferably exceed the height of the raised rings** 26, 28.” The rings are the spacers, and the o-ring is the

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gasket. Thus, Applicant's arguments regarding the alleged deficiencies of Lyman et al are not persuasive.

Therefore, for the reasons presented above, Applicant's arguments regarding the alleged deficiencies of the combination of Dahm et al with Lyman et al are not persuasive and the rejections would be maintained for the reasons detailed in the Final Office Action mailed 6 June 2008.

C. Claims 4 and 7 would be rejected under 35 U.S.C. 103(a) as being unpatentable over Dahm et al (U.S. Patent No. 6,399,394, issued 4 June 2002) in view of Lyman et al (U.S. Patent No. 6,555,361 B1, issued 29 April 2003) as applied to claim 1 above, and further in view of Dickinson et al (U.S. Patent Application Publication No. US 2002/0102578 A1, published 1 August 2002) for the reasons detailed in the Final Office Action mailed 6 June 2008.

D. Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahm et al (U.S. Patent No. 6,399,394, issued 4 June 2002) in view of Lyman et al (U.S. Patent No. 6,555,361 B1, issued 29 April 2003) as applied to claim 1 above, and further in view of Gallagher et al (U. S. Patent Application Publication No. US 2003/0064507 A1, published 3 April 2003) for the reasons detailed in the Final Office Action mailed 6 June 2008.

E. Claims 10-11 and 24-25 would be rejected under 35 U.S.C. 103(a) as being unpatentable over Dahm et al (U.S. Patent No. 6,399,394, issued 4 June 2002) in view of Lyman et al (U.S. Patent No. 6,555,361 B1, issued 29 April 2003) as applied to claim 1 above, and further in view of Frye et al (U. S. Patent No. 6,272,939 B1, issued 14 August 2001) for the reasons detailed in the Final Office Action mailed 6 June 2008.

F. Claim 14 would be rejected under 35 U.S.C. 103(a) as being unpatentable over Dahm et al (U.S. Patent No. 6,399,394, issued 4 June 2002) in view of Lyman et al (U.S. Patent No. 6,555,361 B1, issued 29 April 2003) as applied to claim 1 above, and further in view of Wilding et al (U.S. Patent No. 5,587,128, issued 24 December 1996) for the reasons detailed in the Final Office Action mailed 6 June 2008.

G. Claim 15 would be rejected under 35 U.S.C. 103(a) as being unpatentable over Dahm et al (U.S. Patent No. 6,399,394, issued 4 June 2002) in view of Lyman et al (U.S. Patent No. 6,555,361 B1, issued 29 April 2003) in view of Frye et al (U. S. Patent No. 6,272,939 B1, issued 14 August 2001) as applied to claim 11 above, and furthering view of Wilding et al (U.S. Patent No. 5,587,128, issued 24 December 1996) for the reasons detailed in the Final Office Action mailed 6 June 2008.

H. Claim 23 would be rejected under 35 U.S.C. 103(a) as being unpatentable over Dahm et al (U.S. Patent No. 6,399,394, issued 4 June 2002) in view of Lyman et al (U.S. Patent No. 6,555,361 B1, issued 29 April 2003) as applied to claims 1, 6, and 22

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above, and further in view of Mogard et al (U.S. Patent No. 6,216,905 B1, issued 17 April 2001) for the reasons detailed in the Final Office Action mailed 6 June 2008.

I. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahm et al (U.S. Patent No. 6,399,394, issued 4 June 2002) in view of Lyman et al (U.S. Patent No. 6,555,361 B1, issued 29 April 2003) in view of Frye et al (U. S. Patent No. 6,272,939 B1, issued 14 August 2001) as applied to claims 10 and 11 above, and further in view of Mogard et al (U.S. Patent No. 6,216,905 B1, issued 17 April 2001) for the reasons detailed in the Final Office Action mailed 6 June 2008.

J. Applicant's remaining arguments on pages 10-11 of the Remarks rely on the alleged deficiencies of the combination of Dahm et al with Lyman et al. These arguments are addressed above. Because the arguments are not persuasive, the rejections would be maintained for the reasons detailed in the Final Office Action mailed 6 June 2008.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert T. Crow whose telephone number is (571)272-1113. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert T. Crow/
Examiner, Art Unit 1634

Robert T. Crow
Examiner
Art Unit 1634

/Diana B. Johannsen/
Primary Examiner, Art Unit 1634